

the inventor made on April 26, 1996. See the ATCC Deposit receipt filed in this case on May 28, 1996. See also the Deposit transmittal form filed in this case on May 2, 1996. The history of clone TR2B is clearly laid out in a chain of custody from its reference in the specification of U.S.S.N. 07/391,799 until that deposit. See the Preliminary Amendment filed March 20, 1995 and the Declarations supporting it. It is not new matter to add a deposit accession number for biological material referenced in the specification as filed. Clearly *In re Lundak*, 773 F.2d 1216, 227 USPQ 90 (Fed. Cir. 1983) authorizes the post-filing deposit of biological material referenced in the specification as filed. It necessarily follows that *Lundak* authorizes the addition of the accession number of such a deposit, after filing. Such an amendment is not new matter, and the examiner has provided no authority that would overrule the Federal Circuit's decision in *Lundak* on this point.

There is no basis to believe that the claims are anticipated by the NGF disclosed in Ullrich.

Ullrich discloses nucleic acid encoding a nerve growth factor. The examiner cites Ullrich not because it has "the functional property recited in the claims, and the specification provides no chemical or structural teachings to distinguish the [claimed] human nucleic acid from the prior art...absent evidence to the contrary." (Office action page 9).

The examiner is simply incorrect in saying that the specification contains no chemical or structural teachings to distinguish the claimed nucleic acid from the prior art. The PTO

has permitted claims referencing deposits time and time again, as a way to claim a specific deposited biological material. In this case, the record shows that the material deposited is referenced in the specification, and that material is a portion of MEF2, a gene whose sequence was published later. It is absolutely clear from the record that the claimed deposit 97525 has absolutely nothing at all to do with NGF. The examiner does not even question this fact. It does the patent system no credit to maintain an obviousness rejection that is inconsistent with the record.

The above matters overcome all of the rejections of claim 8, and Applicant respectfully requests indication that claim 8 is allowable.

Claims 9 and 10 are also rejected on the basis of section 112, paragraph 1 as containing subject matter which was not described in the specification to enable the art to make and use the claimed invention.

The Examiner complains that the specification discloses a single embodiment. First, the Applicants note that the specification describes six clones -- the original TR1 (ATCC 68075) and five clones obtained by rescreening: TR2A, TR2B (ATCC 97525), TR3A, TR3B, and TR3C. See page 8, lines 24-33 of the specification, and the Declarations referenced above. Next, the Examiner the specification does not disclose sufficient information as to other species (e.g. sequence of DNA from other species) to make hybridizing nucleic acid. This rejection has been overcome by the amendment.

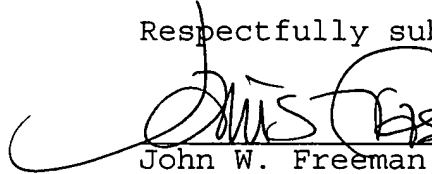
Conclusion

If there are any other charges, or any credits, please
apply them to Deposit Account No. 06-1050.

Respectfully submitted,

Date:

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